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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/688,325      | 10/17/2003  | Robert M. Davis      | 2760-057            | 3000             |

22298 7590 10/05/2005  
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| EXAMINER |
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RODRIGUEZ, JOSEPH C

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| ART UNIT | PAPER NUMBER |
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3653

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Office Action Summary*

Application No.

10/688,325

Applicant(s)

DAVIS ET AL.

Examiner

Joseph C. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/17/03 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

*Ch*

***Final Rejection***

Applicant's arguments filed 7/18/05 have been fully considered but they are not persuasive for reasons detailed below.

The 35 U.S.C. 112 rejections are maintained or modified as follows:

These rejections have been withdrawn.

The prior art rejections are maintained or modified as follows:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-24, 26-30 and 32-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindberg (US 4,377,474).

Lindberg teaches a disc screen (Fig. 1-4) comprising a frame (31); a plurality of shafts (47' and ""); a plurality of discs (38) mounted on the shafts; means for rotatably supporting the shafts (Fig. 1, 2 showing shaft bearings) on the frame so that the discs of adjacent shafts are interleaved and define a laterally inclined trough (pair of four inner shafts 47'; col. 2, ln. 21-40) a pair of vertically inclined regions (outer shafts 47'') extending from opposite sides of the trough (Fig. 2); and drive means (40) connected to the shafts for rotating the shafts in opposite direction (col. 2, ln 20-30). Lindberg also

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teaches means for varying the angle of inclination of the inclined regions (col. 2, ln. 10-21) and of the trough (Id.; col. 2, ln. 45-53).

Further, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the disc screen described above is certainly capable of, inter alia, agitating mixed recyclable material so that mixed recyclable materials deposited on the trough will be divided into streams passing through the discs, over the upper ends of the inclined regions, and off a lower end of the trough. Applicant is also respectfully reminded that the material or article (i.e., mixed recyclables, broken glass, newspapers) worked upon by the apparatus does not limit apparatus claims. See MPEP 2115.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindberg in view of Applicant's Admitted Prior art and Kobayashi (US 5,480,034).

Lindberg as set forth above teaches all that is claimed except for expressly teaching a means for blowing air against the inclined regions. Further, under an

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alternative interpretation, Lindberg may not teach the specific means for varying claimed by Applicant. Kobayashi, however, teaches a disc screen with a means for blowing against an inclined surface (Fig. 9, blowers 45, 46). Moreover, Kobayashi teaches that the blower means aids separation by helping push the materials to be separated up the inclined disk screen surface (col. 7, ln. 10 et seq.). Further, Applicant teaches that the use of a blower means is well known as it prevents objects from falling off of screen ends (para. 06) and Applicant also teaches that the mechanical details, such as screen inclination, of the recycling apparatus are well known (para. 25-29), thus undermining these features as a basis for patentability. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Lindberg as taught above to aid in distributing the materials for separation.

Claims 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lindberg in view of Tirschler (US 5,287,977).

Lindberg as set forth above teaches all that is claimed except for expressly teaching a hollow shaft end with a resilient deformable plug with a stub shaft inserted in the hollow interior of said plug and journaled into a bearing assembly. Tirschler, however, teaches a disc screen with this shaft end feature (Fig. 1, 3, with hollow shaft end near 33 plug 35 stub shaft 1 and bearing assembly shown at top part of fig. 1). Moreover, Tirschler teaches that this feature allows for easier replacement of the disc screen shafts (col. 1, ln. 45-68). Therefore, it would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to modify the invention of Lindberg as taught above.

### ***Response to Arguments***

Applicant's arguments that Lindberg fails to teach the claimed features are unpersuasive. In particular, Applicant's focus on the feature of a laterally inclined trough is misplaced. Lindberg, as cited above and in the original rejection, expressly teaches that "preferably the apparatus is arranged so that the longitudinal axis is inclined at an angle" as this "angle assists in the progression of oversize materials to the outlet" and that "[a]ny suitable means may be provided to adjust the apparatus to attain this inclination" (col. 2, ln. 46-53). Applicant has failed to persuasively address why this explicit teaching does not anticipate the claimed invention. Consequently, as Applicant has not persuasively traversed the rejections with an argument that has not been undermined by the prior art above, the claims stand rejected.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Here, Applicant's Terminal Disclaimer submitted 10/17/03 has been processed but is only applicable to U.S. Patent NO. 6,648,145 B2.

In the interim and due to other applicable patents, claims 34-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,460,706 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other as the instant claims 34-41 are merely broader versions of the previously issued claims. Moreover, Applicant has ample reason to obtain broader claim coverage, thus it would be obvious to modify the claims as currently presented by Applicant.

Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

**<http://pair-direct.uspto.gov>**



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Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).


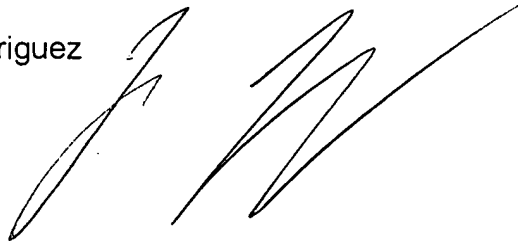
Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **571-272-6584**. Further, the supervisor's contact information is Donald Walsh, 571-272-6944.

Signed by Examiner Joseph Rodriguez

Jcr

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October 2, 2005



DONALD F. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600